

REMARKS

Claims 1-7 are now pending. Claims 1 and 4 have been amended. The amendments are supported in the original claims and throughout the specification, in particular at pages 6 and 7.

The following remarks are in response to the Office Action mailed July 31, 2008.

Claim Objections and Rejections – 35 U. S.C. § 112

Claim 4 stands objected to as having informalities and rejected under 35 U.S.C. § 112 as indefinite. Both problems are believed to be addressed by the present amendment to claim 4, which clarifies that, as the Examiner surmised, the word “participant” was inadvertently omitted from the original claim. This amendment is supported, for example, at page 6, line 30 – page 7, line 1 of the subject specification.

Claim Rejections – 35 U. S.C. § 101

Claims 1-7 stand rejected under 35 U. S.C. § 101 as directed to non-statutory subject matter. While Applicant does not agree with the Patent Office’s interpretation of section 101, claim 1 has been amended to clarify that the claimed method is tied to a computer. This amendment is believed sufficient to overcome the pending § 101 rejections of claims 1-7.

Claim Rejections – 35 U. S.C. § 102

Claims 1-5 stand rejected under 35 U.S.C. § 102 as anticipated by Wooten (U.S. Pat. App. Pub. 20030088479 A1). These rejections are respectfully traversed.

As is made clear from the subject specification (and even more clear by the present amendments to claim 1), an “on call date” is a date on which a participant (typically an expert in a particular field) is willing to be available (i.e., “on call”) to provide expert advice to potential callers.

In contrast, the portion of Wooten relied upon in the Office Action is directed to a method of allowing physicians to schedule dates on which they’re available for sales calls from pharmaceutical sales representatives (see, for example, Wooten, pars. [0053] and [0054]). Thus, in Wooten, the physician is not providing advice, but rather is letting salespeople know when the physician is willing to receive sales pitches (see par. [0004] of Wooten for an explanation of the

motivation for such a system). Thus, Wooten does not describe an on call system as that term is used in the subject specification and claims— that is, a system that provides for scheduling dates or times during which an participant (e.g., an expert) is available for consultation.

Moreover, Wooten fails to teach the “qualifications” element of claim 1. The Office Action cites to Wooten, par. [0045], as teaching this limitation, but that paragraph only discusses allowing a buyer (e.g., a physician) to exclude undesirable sellers. This has nothing to do with a participant’s qualifications – that is, for example, an expert’s reasons for claiming to be an expert.

Applicant is unaware of any definition of the word “qualification” that would allow claim 1 to encompass the “exclusion list” of Wooten, and respectfully requests a citation to a published reference containing such a definition, if this rejection is maintained by the Patent Office.

In light of the above, reconsideration and withdrawal of the rejection of claim 1 is respectfully requested.

Claim 2 is rejected based on a misinterpretation of Wooten. In the rejection of claim 1, the Office Action interprets the “participant” of claim 1 to be the “buyer” of Wooten, and so the “seller” of Wooten must be a “caller” of claim 2. But the Office Action reverses this mapping in its rejection of claim 2, and analogizes the “caller” of claim 2 to a “participant.” Applicant respectfully submits that: (a) both interpretations cannot be correct; and (b) the first interpretation (i.e., that “sellers” are callers) is the only one that makes some sense (although the “sellers” of Wooten do not actually correspond to the “callers” of claims 2-7. In light of the above, reconsideration and withdrawal of the rejection of claim 2 is respectfully requested.

The rejection of claim 3 is not understood by Applicant. While claim 3 requires “assigning said participant to a group associated with a topic, and wherein a potential caller does not have access to contact information for said participant unless said potential caller has indicated an interest in said topic,” none of the Wooten language cited in the Office Action is related to those limitations. The cited language says nothing about assigning a participant to a group associated with a topic, or about providing a caller with access to contact information only if the caller has expressed interest in the topic for the group to which the participant has been

assigned. The same language is cited against claims 4 and 5. Clarification is respectfully requested.

Claim Rejections – 35 U. S.C. § 103

Claim 6 stands rejected under 35 U.S.C. § 103 as unpatentable over Wooten in view of Maes (U.S. Pat. App. Pub. No. 20020002502) and in further view of Official Notice. This rejection is respectfully traversed, for the following reasons.

First, the rejection relies on the rejections of claims 1 and 3, which are explained above to have been erroneous.

Second, the rejection is not supported by Maes. Maes says nothing about a caller (or anyone else) expressing an interest in a topic by downloading one or more publications. Maes merely discusses a user requesting information of interest.

Third, Applicant respectfully traversed the taking of Official Notice, and pursuant to MPEP 2144.03, respectfully requests documentary evidence to be provided in the next Office Action if the rejection is to be maintained. Clicking on a web browser may or may not cause a file to be downloaded and displayed, and in any event downloading a file does not necessarily result in a publication. Moreover, even if the statement of Official Notice were accurate, it is not relevant to claim 6, which requires downloading one or more publications associated with a certain topic and having the caller, the downloading, and the topic recorded as an expression of interest.

Fourth, the rejection of claim 6 is based on a piecemeal deconstruction of the claim, and ignores the claim as a whole. Neither of the cited references, either separately or in combination, teaches or suggests anything close to the claimed invention.

In making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention “as a whole.” Inventions almost always are new combinations of existing principles or features. The “as a whole” requirement in section 103 and MPEP 2141.02 (“the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious”) prevents evaluation of the invention part by part.

Without this important requirement, an Examiner seeking to reject a claim could simply break a claim into its component parts, then find a prior art reference corresponding to each component. This approach improperly imports hindsight into the obviousness determination by using the invention as a roadmap to find its separate components in the prior art. Further, this improper method discounts the value of combining various existing features or principles in a new way to achieve a new result - often the essence of invention.

The mere fact that some words in the claim also can be found in the references does not mean that those references teach any of the claim limitations.

Fifth, the asserted ground for combining Wooten with Maes is not the sort of articulated reasoning required by the Patent Office Examination Guidelines for Determining Obviousness, which state: “Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See also MPEP 2142(I).

Here, the asserted ground for combining the references is: “to further develop feedback information for use as in Wooten because such feedback information is useful in helping create better marketing (Wooten [0050]) and the benefits of using such information would have been predictable.” This is not “articulated reasoning” with “rational underpinning.” It is misleading (Wooten’s buyers and sellers are arranged in a way such that any feedback in Wooten would be useless in the claimed invention). Nor is there is any explanation of how such feedback would work (i.e., who is providing feedback to whom) or how it would “create better marketing.” The latter is precisely the kind of conclusory statement prohibited by the PTO Examination Guidelines and *KSR*.

Claim 7 stands rejected under 35 U.S.C. § 103 as unpatentable over Wooten as applied to claim 2 and further in view of Katz (U.S. Pat. No. 6,148,065). This rejection is respectfully traversed, for the following reasons.

First, as the Office Action admits, the rejection relies on the rejection of claim 2, which is explained above to have been in error.

Second, the rejection of claim 7 shares the same flaws as that of claim 6: claim 7 as a whole is not addressed; the limitations of claim 7 admitted to be missing from Wooten are not

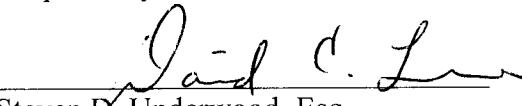
found in Katz; and there is no credible explanation of why one skilled in the art would be motivated to combine the teachings of Katz with those of Wooten, how that combination would work, or why such a combination would result in the invention of claim 7. Indeed, there is no teaching in either Wooten, Katz, or the combination thereof that even remotely suggests the invention of claim 7.

In light of the above, all claim objections and rejections are believed overcome by this Response, and prompt allowance of the pending claims is respectfully requested.

No fee is believed to be due with this Response, other than the requisite extension fee. However, if any other fee is due, please charge that fee to Deposit Account No. 50-0310.

Respectfully submitted,

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